

## **REMARKS/ARGUMENTS**

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicant originally submitted Claims 1-20 in the application. The Applicant has amended Claims 1, 8 and 15, and have canceled Claims 5, 12 and 19. The Applicant has not added any claims. Accordingly, Claims 1-4, 6-11, 13-18 and 20 are currently pending in the application.

### **I. Rejection of Claims 1-20 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,774,170 to Hite, *et al.* (Hite), in view of U.S. Patent No. 5,026,152 to Sharkey. As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

At the outset the Applicant respectfully calls the Examiner's attention to the fact that the Examiner has given no reason why a person of ordinary skill in the pertinent art would be motivated to combine the two cited references. The Applicant suggests that there is a distinct difference between the distribution of advertising in the context of a commercial television or radio broadcast as described in Hite and the distribution of advertising for movie theatres and similar non-broadcast venues. No specific reason has been set forth by the Examiner on why Hite is viewed as being analogous to the operation of a movie theatre. The Applicant respectfully suggests that the broadcasting business and the movie theatre business are separate and distinct disciplines. A person of ordinary skill in the art of one would have no reason to look to the other for ideas. Referring to *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), the Federal Circuit stated that:

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reasons the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffett*, 149, F3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the would have been motivated to select the references and to combine to render the claimed invention obvious.") *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

No objective factor has been given that would motivate a person of ordinary skill in the pertinent art to refer to the respective references and then to combine them. There is no teaching or suggestion in either reference that the two references should be combined nor the desirability of such a combination. As stated in *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), “[t]he mere fact that ... disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination.” *In re Imperato*. 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). “The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *Ex parte Dussaud*, 7 USPQ1818, 1820 (Bd. App. & Int’f 1986). There is nothing in Hite that suggests it should or could be combined with Sharkey, nor is there anything in Sharkey that suggests it should or could be combined with Hite. The mere fact that isolated references are found to establish a combination does not render the combination obvious unless something suggests the desirability of the combination, which is not the case here. Hite, individually or in combination with Sharkey, fails to teach or suggest the invention recited in independent Claims 1, 8 and 15 and their dependent claims, when considered as a whole.

Hite discloses a system for enhancing television and radio advertising by targeting, delivering and displaying electronic advertising messages commercials within specified programming in one or more pre-determined households or on specific display devices while simultaneously preventing a commercial from being displayed in other households or on other displays for which it is not intended. The system in Hite permits commercials to be delivered to specified homes or displays via either over-the-air or wired delivery systems. Hite is directed to broadcast media and not to theatre displays. Hite selects certain advertising features to be delivered

to targeted broadcast media audiences or display venues and displays them from a central server. (Abstract). Hite does not deliver advertisements to a theatre venue. Hite does not describe a system of providing advertising to be stored at the site of a geographically distributed displays with an associated local storage unit for locally storing the advertisements displays where the storage units are associated with a corresponding plurality of theatres. Hite describes a facility where advertising can be stored (Col. 14, lines 28-56), but the facility described in Hite relates to storage of an advertisement for the running of an advertisement in the context of a television or radio program where a commercial break is part of the program. This system is not analogous to the system described in the present invention.

Sharkey does not overcome the shortcoming of Hite. Sharkey describes an enhanced cinema system that can be used with a movie screen where a fog-like gas is released from a plurality of retractable shafts having slits. This plurality of shafts can spin to generate a fog effect with the fog-like gas escaping from the slits. A movie projector can then be used to project a movie or advertisement onto a movie screen with signals causing a laser beam of light to interact with the movie and fog-like gas in front of the movie screen. Sharkey also describes programmable lighting panels mounted on the side walls of the movie theater and, in response to a lighting signal from the movie projector, lights in the panels that are activated during a movie. Sharkey also provides for a cinema system that can include a remote location coupled to the enhanced cinemas, for distributing programs through a communications channel or other medium. (Abstract). As was the case with Hite, Sharkey does not deliver advertisements to a theatre venue where they will be stored and displayed as part of a theatre presentation. Sharkey does not describe a system of providing

advertising to be stored at the site of a geographically distributed displays with an associated local storage unit for locally storing the advertisements.

Hite, individually or in combination with Sharkey, thus fails to teach or suggest the invention recited in independent Claims 1, 8 and 15 and their dependent claims, when considered as a whole. Claims 1-4, 6-11, 13-18 and 20 are therefore not obvious in view of Hite and Sharkey. In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-4, 6-11, 13-18 and 20 under 35 U.S.C. §103(a). The Applicant therefore respectfully request the Examiner to withdraw the rejection.

## II. Conclusion

In view of the foregoing amendment and remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-4, 6-11, 13-18 and 20.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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